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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,243	01/05/2001	Rudolfus A.T.M. Van Benthem	P 275922 9637US/CONT	3640

909 7590 04/14/2003

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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/754,243

Applicant(s)

VAN BENTHEM ET AL.

Examiner

Susan W Berman

Art Unit

1711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: SEE ATTACHED PAGE(S).
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 22 and 23.Claim(s) rejected: 2,3,9-21,24-27.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Susan W Berman  
Primary Examiner  
Art Unit: 1711

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*Detailed Advisory*

Claims 2, 24, 25 and 27 have been amended to recite that the polymer "P" is a condensation polymer. This amendment does not distinguish the instantly claimed polymeric compound from the polymeric cellulose compound disclosed by Nason et al, of record. The amendment does distinguish the instantly claimed polymeric compound from the polymers disclosed by Tomalia et al (3,928,499), Stockinger et al (6,470,587) or Goldenberg (4,665,123) cited herein.

It is not agreed that the language of the instant claims requires a construction in which the group "A", whether a monovalent or polyvalent organic group or a polymer "P", is bonded to a carbon atom of the carbonyl group (C=O) by a carbon-carbon double bond ( it is assumed that applicant intended a carbon to carbon single bond). Nothing in the definition of "A" as a polymer "P" requires that the link from "P" to the carbonyl group in the amide group is a carbon to carbon bond. "P" is simply defined as a "polymer", thus including any polymer of any known polymeric structure bonded to the carbonyl group shown in the alkylamide formula. The designation "P" does not define the kind of bond between the polymer and the carbonyl group in the alkylamide. Furthermore, the claims, as written, do not require a reaction product of an alpha,beta-ethylenically unsaturated carboxylic acid, such as methacrylic acid, and an epsilon-hydroxy-pentyl oxazoline or a beta-hydroxy alkylamide compound containing two different hydroxyl groups as set forth on page 6 of paper number 20 resulting in a compound wherein "A" is  $-(CH_2)_6OH$ . The claim language "hydroxy-alkylamide group-containing compound" suggests that the ester is provided by a reaction between the hydroxy group in the alkylamide and the acid group in the unsaturated acid.

Applicant refers too the compound of Experiment 6 on page 15 of the specification as a comparison or control example; however, there is no corresponding disclosure in the specification as filed that this example is a comparison or control example rather than an example of the instantly claimed

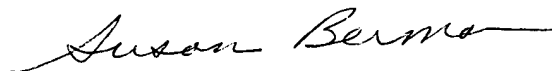
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invention. The examiner only acknowledged that applicant's attorney described Experiment 6 as being a comparison or control, not that the disclosure sets forth that Experiment 6 is a comparison or control.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman  
Primary Examiner  
Art Unit 1711

SB  
April 11, 2003